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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,503	10/18/1999	CAMERON STUART BIRSE	004860.P2434	2896

7590 11/04/2004  
BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD 7TH FLOOR  
LOS ANGELES, CA 90025

EXAMINER

VU, THONG H

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/420,503

Applicant(s)

BIRSE ET AL.

Examiner

Thong H Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ♦  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 1-15 are pending.
2. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 are rejected under the judicially created doctrine of double patenting over claims 1-11 of U. S. Patent No. 6,751,658 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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(Claim 1, Patent 658)

A method comprising: a network computer (NC) client booting from a boot image provided by an NC server, the boot image including information identifying the location of one or more user system volumes on the NC server, the NC client locally executing the boot image and mounting the one or more system volumes, the one or more user system volumes containing operating system software; and in response to an attempt to modify the contents of the one or more user system volumes, the NC client causing information identifying a modification associated with the attempt to be recorded on the NC server separate from the one or more user system volumes in a shadow system volume associated with the NC client;

wherein the one or more system volumes are presented to the NC client as a split operating system including a core operating system volume that can be read but not written by the NC client and the user operating system volume that can be read and/or written by the NC client, wherein the storage area associated with the NC client comprises the shadow volume corresponding to the user operating system volume, and wherein the NC client causing information identifying a modification associated with the attempt to be recorded comprises tracking modifications to the user operating system volume in the shadow volume.

(Claim 1, application) A method comprising a first network computer client of a plurality of NC clients causing other of the plurality of NC clients that are subsequently booted from a network to receive a second operating system software that is configured differently than a first operating system software by replacing a first set of one or more system volumes maintained at a NC server containing the first operating system software with a second set of one or more system volumes maintained at the NC server containing second operating system software.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. § 103 as being unpatentable over by McCall et al [McCall 6,317,826 B1] in view of Blumenau [6,631,442 B1].
5. As per claim 1, McCall discloses a method comprising a first network computer client of a plurality of NC clients [McCall, client and server Fig 1] causing other of the plurality of clients that are subsequently booted from a network to receive operating system software [McCall, subsequently modify the operating system and reboot, col 5 lines 27-38] that is configured differently [McCall, different configuration files, col 3 lines 32-col 4 line 63] than a first operating system software in effect by replacing a first set of files or system volume maintained at a server [McCall, different versions of batch file, col 3 lines 5-17] the server containing the first operating system software with a second set of files or system volume maintained at the NC server containing second operating

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system software [McCall, the server stored the generic boot image as the first operating system software and the modified version as a second operating software, col 4 lines 57-67; the boot image includes a number of files, col 2 lines 27-38].

McCall did not detail the set of files as one system volume. A skilled artisan would have motivation to improve the technique of detect and update a set of files or a system volume on the computer system and found Blumenau teaching. Blumenau discloses a method and system for interfacing a data storage associated to a plurality of computing devices wherein the label manager determined the volume information and replacing a set of files or a set of volumes for a specific computing device [Blumenau, col 9 lines 45-60; col 10 lines 7-56; col 14 lines 12 et seq].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of replacing a volume of a computing device as taught by Blumenau into the McCall's apparatus in order to improve the configuration of the operating system software. Doing so would provide a dynamic, efficiency and reliability to update the system files in the network environment.

6. Claims 2,3,11-15 contain the similar limitations set forth of apparatus claim 1. Therefore, claims 2,3,11-15 are rejected for the similar rationale set forth in claim 1.

7. As per claims 4,7,9 McCall-Blumenau disclose the NC client causing those of the plurality of NC clients that subsequently open an application to utilize a modified version of the application by replacing the first set of one system volume, [McCall, subsequently

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modify the operating system and reboot, col 5 lines 27-38] wherein the first set of one system volume further comprises application software as a design choice of bootstrap program or operating system software.

8. As per claim 5, McCall discloses wherein at least one NC client is not rebooted for a period of time after replacing the first set of one system volume [McCall, if the client operating system is to be re-booted, col 2 lines 48-56].

9. As per claims 6,8,10 McCall-Blumenau disclose the operating software as UNIX and MS-DOS [McCall, DOS operating system, col 2 lines 48-56].

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904.

The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

*Thong Vu*  
**Patent Examiner**  
**Art Unit 2142**

